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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,042	08/06/2001	Marilyn Wood Blaschke	194-26572-US	8965

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EXAMINER

MANOHARAN, VIRGINIA

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,042	Applicant(s) BLASCHKE, MARILYN WOOD	
	Examiner Virginia Manoharan	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28,30-32,35-46,68-78 and 109-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-28,30-32,35-46,68-78 and 109-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The indicated allowability of claims 16-28, 30-32, 35-46, 68-78, and 109-113 is withdrawn in view of the new rejections, indicated below.

Claims 16-28, 30-32, 35-46, 68-78 and 109-113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a). The claimed "solvent" in claim 17 lacks proper antecedent basis for support as it is not positively recited in claim 109 that the "blend" is comprised of a solvent and at least one fouling agent. Note also claims 111 and 113.
- b). The numerously recited "20 ppm or more " and "50 ppm or more" should be --at least 20 ppm --, and --at least 50 ppm-- respectively so as to avoid the alternative "or". See for examples only: claims 38-39 and claims 41-44.
- c). The preamble of claim 38 recites "...preventing fouling of equipment during solvent recovery in a diene plant, however, the body of the claim does not mention the above limitation(s). See also claims 41, 43 and 109-113.
- d). Claims 38, 41 and 43 do not differ substantially with one another as required under 37CFR 1.75 (b) far as method/process steps are concerned. The only difference seen, is that claim 38, for example, recites N,N,-diakylamide of fatty acid, whereas claim 41 recites N,N—dialkylamide of tall oil fatty acid, and further claim 43 recites N,N,-dimethylamide of fatty acid. However, said difference does not constitute a patentable distinction as they are more product limitation(s) in "product claims", rather than

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process/method limitations to which the claims are directed. The same hold true for claims 109-113.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-28, 30-32, 35-46, 68-78 and 109-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZA 68/05343 (translation) or Ferm (4,410,419) with or without Cooper (5,746, 924).

ZA '343 or Ferm discloses the process/method of treating a solvent recovery blend comprising solvent and at least one fouling agent with N,N-dialkyl amide of fatty acid in an amount of about 20 ppm or more as broadly claimed e.g., in claim 38. The same applies to other independent claims. See entire translation of ZA '343, and the claims at cols. 3 and 4 of Ferm. The inorganic suspended solids and water of ZA '343 would read on the broadly claimed "fouling agents" and "solvent" respectively. The claimed method for preventing fouling of equipment during solvent recovery in a diene plant has no patentable moment as it is simply recited in the preamble e.g., of claim 38. The preamble may or may not even be given patentable weight. Nonetheless, Cooper discloses the concept of using antifoulant in a solvent recovery system with acrylonitrile e.g., as the solvent. Given that concept [In re Bascom, 230 F. 2d 612, 109 USPQ 98 (CCPA 1956)], one would have been led to incorporate the process of

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preventing fouling of equipment during solvent recovery, as in claim 38, motivated by the reasonable expectation of reusing the same solvent for economic reason.

Incorporating the subject matter of combined claims 16 and 36 to all the independent claims would place the case in condition for allowance.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wong discloses controlling particle size and eliminate fouling in a system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Manoharan whose telephone number is (571) 272-1450.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PRIMARY EXAMINER
AST UNIT 1831 744
3/20/04